



UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/473,386	12/28/99	GUILLEN	M BAL6019P0090

ROCKEY MILNAMOW & KATZ LTD  
TWO PRUDENTIAL PLAZA  
180 N STETSON AVE STE 4700  
CHICAGO IL 60601

HM12/0703

EXAMINER

HM12/0703  
ART UNIT PAPER NUMBER

1661

DATE MAILED:

07/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/473,386

Applicant(s)

GUILLEN, MARIO

Examiner

June Hwu

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Art Unit: 1661

### DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1661.

### Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

OK  
It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

### Drawing

2. Color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) or (b)(2) is granted permitting their use as formal drawings. In the event applicant wishes to use the drawings currently on file as formal drawings, a petition must be filed for acceptance of the photographs or color drawings as formal drawings. Any such petition must be accompanied by the appropriate fee as set forth in 37 CFR 1.17(i), three sets of drawings or photographs, as appropriate, and an amendment to the first paragraph of the brief description of the drawings section of the specification which states:

will hold  
filing of petition  
until allowance

Art Unit: 1661

The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.

Color photographs will be accepted, if the conditions for accepting color drawings have been satisfied.

### Claim Rejections – Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 2-4 and 6 are provisionally rejected under the judicially created doctrine of obviousness-double patenting as being unpatentable over claim 1 of co-pending application number 09/473,000.

The claims in the present and co-pending application are drawn to the instant plant *Impatiens* 'Balfafdala' wherein the plants, pollen, ovule, and cuttings are inherent from the parent application. The subject matter of the instant claims 2-4 and 6 are encompassed by claim 1 of application numbers 09/473,000.

hold filing  
of terminal  
disclaimer  
until notice  
of allowance

Art Unit: 1661

This is a provisional obviousness-type double patenting rejection because the co-pending application has not been allowed.

4. Claims 2-4 and 6 are provisionally rejected under the judicially created doctrine of obviousness-double patenting as being unpatentable over claim 1 of co-pending application number 09/473,008.

The claims in the present and co-pending application are drawn to the instant plant *Impatiens* 'Balfafusia' wherein the plants, pollen, ovule, and cuttings are inherent from the parent application. The subject matter of the instant claims 2-4 and 6 are encompassed by claim 1 of application numbers 09/473,008.

This is a provisional obviousness-type double patenting rejection because the co-pending application has not been allowed.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

### **Written Description**

5. Claims 1, 3-6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

*Claims  
have been  
deleted*

Claim 1 is drawn to any trailing interspecific *impatiens* plant. Claims 3-6 are drawn to pollen, ovule, regenerable cells and cutting of a trailing interspecific *impatiens* plant. However, the specification only discloses the crossing of *Impatiens flaccida* with *Impatiens hawkeri* resulting in a progeny with a trailing habit such as 2245B and 2257B. There are no other examples given with this combination. The *Impatiens* is a broad group of plants comprising approximately 800 species. Thus, there are millions of possible interspecific hybrids.

In analyzing whether the written description requirement is met for genus claims, it is first determined whether a representative number of species have been described by their complete structure. It is not realistic to expect that the "complete structure" of the trailing *impatiens* plant could be described. Therefore the inquiry required by this portion of the written description guidelines is interpreted to be whether the phenotypes of all the claimed hybrid *impatiens* have been described. In this case, the few disclosed embodiments are not representative of the enormous number of products claimed. Plants have many phenotypic characteristics, which vary independently. The claims encompass *impatiens* having one fixed characteristic, low or procumbent habit, however an enormous number of other undisclosed phenotypic traits are not disclosed.

Next, then, it is determined whether a representative number of species have been sufficiently described by other relevant identifying characteristics. The limited disclosure in the specification is not deemed sufficient to reasonably convey to one skilled in the art that Applicant was in possession of the full scope of the genus recited

Art Unit: 1661

in the claims at the time the application was filed. Thus it is concluded that the written description requirement is not satisfied for the claimed genus.

### **Enablement**

6. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a hybrid impatiens plant *Impatiens flaccida* x *Impatiens hawkeri* with a trailing habit does not reasonably provide enablement for any other embodiment encompassed by the claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Claim 1 recites any trailing interspecific impatiens plant wherein the plant includes the pollen, ovule, regenerable tissue cells and cuttings (claims 3-6). The nature of the invention encompasses any hybrid impatiens plant with a trailing habit. In addition, the state of the art at the time the invention was filed does not enable a person skilled in the art to make the invention because of lack of guidance and uncertain predictability. The specification does not provide sufficient amount of direction or guidance to enable a person skilled in the art to make the invention with the phenotype disclosed. There was no prior art known to the examiner that taught the crossing of *Impatiens flaccida* and *Impatiens hawkeri* with viable seeds (Arisumi, 1985). Furthermore, the hybridization of the impatiens plants will create unpredictable offspring with unknown characteristics. One skilled in the art would not readily anticipate the outcome of the claimed invention because there would be an almost unlimited number

Art Unit: 1661

of combinations that may occur and are not disclosed in the specification except their own experiments. However, specification does not enable a person skill in the art to make the claimed invention without undue experimentation, because the specification only teaches the crossing of *Impatiens flaccida* with *Impatiens hawkeri*.

With regard to claim 2, the invention employs novel plants, seeds and plant parts. Since the plants of 2245B and 2257B are essential to the claimed invention they must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If they are not so obtainable or available, the requirements of 35 U.S.C. § 112, regarding "how to make" the invention may be satisfied by deposit. For the plant, a deposit of 2500 seeds is considered adequate to ensure availability of each claimed embodiment. The specification does not disclose a repeatable process to obtain the plants, seeds or plant parts, because it does not appear that the two parental lines are readily available to the public. Even if the parents were available, then the progeny would not be identical to the named plants unless they were both inbred lines. If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the specific plant line has been deposited under the Budapest Treaty and that it will be irrevocably and without restriction released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein.

If the deposit is not made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 CFR 1.801-1.809, applicants may provide



Art Unit: 1661

assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that

- (a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
- (b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- (c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer; and,
- (d) a test of the viability of the biological material at the time of deposit (see 37 CFR 1.807); and,
- (e) the deposit will be replaced if it should ever become inviable.

The applicant can deposit regenerable tissues from the offspring of *Impatiens flaccida* and *Impatiens hawkerii* with the public depository of applicant's choice.

Claims 3-6 are dependent on claims 1 and 2 and are rejected as stated above.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 2-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

only *I. flaccida*  
seeds were  
deposited

Art Unit: 1661

Claim 2 is indefinite in its recitation of "derivatives", which fails to clearly set the metes and bounds of the claimed invention. The term "derivatives" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

8. Claims 3-6 are dependent on claim 2 and are rejected as stated above.

9. Claim 7 is indefinite and confusing in its recitation of "regenerating", which is an improper term used to describe the development of plants.

10. Claims 8-12 are dependent on claim 7 and are rejected as stated above

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 3, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hope (P.P. 5,921)

Claims 1, 3,4 and 6 are drawn to any trailing hybrid *impatiens* plant, which includes its pollen, ovule, and cuttings. Hope teaches that crossing two *impatiens* plants, *Impatiens mooreana* and *Impatiens schlechterii* will produce a hybrid with a spreading characteristic perfect for hanging basket (column 1, lines 30-35). Hope has shown that under controlled breeding program he was able to produce a New Guinea *impatiens* plant with a spreading characteristic. Thus, Hope anticipates the claimed invention of hybrid interspecific trailing *impatiens*.

12. Claims 1, 3, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hope (P.P. 5,698).

Claims 1, 3,4 and 6 are drawn to any trailing hybrid *impatiens* plant, which includes its pollen, ovule, and cuttings. Hope again teaches the breeding of two *Impatiens* species, *Impatiens schlechterii* and *Impatiens platypetala* 'Tangerine' will create a hybrid plant with a compact, spreading habit appropriate for hanging basket (column 1, lines 33-36). Therefore, Hope anticipates the claimed invention of a hybrid interspecific trailing *impatiens*.

13. Claims 1, 3, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hope (P.P. 5,598).

Claims 1, 3,4 and 6 are drawn to any trailing hybrid *impatiens* plant, which includes its pollen, ovule, and cuttings. Hope has shown the method of controlled breeding of two species, *Impatiens herzogii* and *Impatiens schlechterii*, that will produce

Art Unit: 1661

the phenotype described (column 1, lines 34-36). In conclusion, Hope anticipates the claimed invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hope (P.P. 5,921) in view of Banner et al.

Hope discloses a method of producing a low, spreading hybrid impatiens plants for commercial purpose. The hybrid impatiens plants include the plant, pollen, ovule and cuttings. Hope does not expressly disclose tissue culturing of cell tissue from trailing interspecific impatiens plants. Banner et al have stated that the propagators use the tissue culture method to produce virus free stock (page 16). At the time the invention was made it would have been obvious to a person of ordinary skill in the art to use tissue culture as a form of developing virus free stock of Hope's plants.

**Conclusion**

15. No claims are allowed.

16. Claims 7-12 are free of the prior art because the prior art did not teach or suggest the specific hybrid of *Impatiens flaccida* cross with *Impatiens hawkeri* or the resulting trailing growth habit.

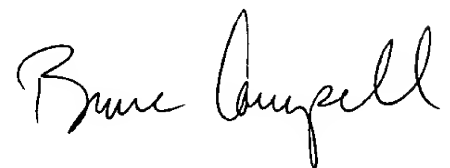
### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (703) 308-5017. The Examiner can normally be reached Monday through Thursday from 7:00 a.m. to 4:30 p.m. and off alternate Friday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

June Hwu

A handwritten signature in black ink that reads "Bruce Campell". The signature is written in a cursive, flowing style.

**BRUCE R. CAMPELL, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600**